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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,833	12/04/2003	Roger Lok	87028SMR	7419
7590	03/22/2005		EXAMINER LE, HOA VAN	
Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 03/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,833	LOK ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 11-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04 December 2003</u> . | 6) <input type="checkbox"/> Other: ____. |

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This application is before the examiner for consideration on the merits.

I. Claims 1-20 are generic to a plurality of disclosed patentably distinct species comprising many possible compounds of the general formula I. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

II. Applicants elect compound 1 on page 10 of the specification on 03 March 2005 being acknowledged. The elected species of compound 1 has been considered and searched. The consideration and search are extended to the applied species. Others have not been considered, searched or examined until all of the applied species are overcome.

III. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 1-3 and 11-16 with respect to the applied species are rejected under 35

U.S.C. 102(b) as being anticipated by Stauffer et al (2,472,631).

Stauffer et al disclose, teach, demonstrate and reduce to practice with a silver halide photographic material comprising a support having thereon an silver halide emulsion layer containing a thiocyanato palladite being read within the general formula I as claimed. Please see the whole disclosure of the applied reference, especially at col.11-2 and 48-49, Sample No. 2, Example 1, 4:11-50 and 76. The language "emulsion layer being...thiocyanato compound" and "wherein Plug...PUG-S" are and have been considered as functional property of the materials. It has reasonable to believed that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in In re Schreiber, 44 USPQ2d 1429. Since Stauffer et al disclose, teach, demonstrate and suggest the embodiments in the claims, the above claims are found to be anticipated by Stauffer et al.

IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 11-20 with respect to the applied species are rejected under 35 U.S.C.

103(a) as being unpatentable over Stauffer et al (2,472, 631) considered in view of Nietz et al (2,222,264) and Lok (5,914,226).

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Stauffer et al disclose, teach, demonstrate and reduce to practice with a silver halide photographic material comprising a support having thereon an silver halide emulsion layer containing a thiocyanato palladite being read within the general formula I as claimed. Please see the whole disclosure of the applied reference, especially at col.11-2 and 48-49, Sample No. 2, Example 1, 4:11-50 and 76. The language "emulsion layer being...thiocyanato compound" and "wherein Plug...PUG-S" are and have been considered as functional property of the materials. It has reasonable to believe that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Stauffer et al do not specify a dispersion in claim 20. Russell et al at page 2, left column lines 45-51 disclose, teach and suggest that the use of a soluble gold thiocyanato can be used in either solution or dispersion form to obtain the same an increasing speed property at page 1, left column, line 53 and right column, line 21-22.

Stauffer et al do not specify a sulfinate compound in claim 17-19. Lok at col.8:26 to 9:3 is cited to show the known use of the sulfinate compound to obtain stable photographic material having 95 or more mole percent silver chloride at col.1:7-7 and 10:6-17.

Since the above references are all related to improvements of photographic materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known use of a water soluble thiocyanato containing compound in either solution or dispersion for a reasonable expectation of obtaining the same or about the same increasing speed property as disclosed, taught and suggested in Nietz et al and/or use or cite the

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known sulfinate compound for a reasonable expectation of obtaining stable photographic material as disclosed, taught, suggested and obtained in Lok.

V. Claims 4-10 are related to species being other than compound 1 as elected of the general formula I. The above applied references do not specify them. They are properly withdrawn for now as being non-elected species. They will be considered when all of the applied species on the record are overcome.

VI. Loria et al (3,253,924) is cited to show the state of the art wherein up on color development "thiocyanate ion" or "-SCN" ion is release from W-SCN with "W" being equivalent to "PUG" in the claims. No "useful mercaptan" of PUG-S as claimed.

VII. If applicants provide a reasonable evidence that the above applied references do not provide the "useful mercaptan" of PUG-S as claimed as that in Loria et al the above applied references will be withdrawn. The same will also do for each of the following references: Burt (3,607,288), Gerber et al (3,852,072), Brown (4,468,454) and Machine English language translation of JP 07-282333 are cumulative to the above applied references. JP (45-2871) and (4-125629) and DE (37 30 557) and (198 30 439) have been requested for their English language translations to speed up the prosecution and allow the claims.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

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The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
14 March 2005

HOA VAN LE
PRIMARY EXAMINER

